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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,847	06/19/2000	RONEN SANDER	MERCK-2114	4887

7590

05/08/2002

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EXAMINER

PAK, JOHN D

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/581,847

Applicant(s)
SANDER

Examiner
Pak, J.

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 4, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 (but see comments in the Office Action, page 5) is/are allowed.
- 6) ☒ Claim(s) 18-21 and 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Claims 18-31 are pending in this application.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21, 24-28 and 31 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marco for the reasons of record.

Applicant places great reliance on the claim term "interference pigment" and the supposed specialized definition that it should be afforded. However, applicant is reminded that the originally filed disclosure makes no explicit mention of the term "interference pigment" and provides no specialized definition for this term. Therefore, without proper basis for a specialized definition, its ordinary meaning must be used, i.e. a pigment that provides interference. The Examiner maintains that Marco's whitewashes of reflective materials meet such claim interpretation. No modification of Marco's teachings is necessary because the instant claims, as interpreted above, literally read on Marco's disclosure.

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Claims 18-21 and 24-28 stand rejected under 35 U.S.C. 102(b) as anticipated by JP 60-149508 for the reasons of record.

Applicant places great reliance on the claim term “interference pigment” and the supposed specialized definition that it should be afforded. However, applicant is reminded that the originally filed disclosure makes no explicit mention of the term “interference pigment” and provides no specialized definition for this term. Therefore, without proper basis for a specialized definition, its ordinary meaning must be used, i.e. a pigment that provides interference. The Examiner maintains that reflective materials used in the cited reference meet such claim interpretation. No modification of the reference teachings is necessary because the instant claims, as interpreted above, literally read on its disclosure.

Claims 25-27 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Letteron for the reasons of record.

Applicant places great reliance on the claim term “interference pigment” and the supposed specialized definition that it should be afforded. However, applicant is reminded that the originally filed disclosure makes no explicit mention of the term “interference pigment” and provides no specialized definition for this term. Therefore, without proper basis for a specialized definition, its ordinary meaning must be used, i.e. a pigment that provides interference. The Examiner maintains that mica flakes used by Letteron meet such claim interpretation. No modification of Letteron’s teachings is necessary because the instant claims, as interpreted above, literally read on Letteron’s disclosure.

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Applicant also argues that Letteron is additionally distinguished from the method claims, but this ground of rejection is directed only against claims 25-27, which are all composition claims.

Claims 25-27 and 29-30 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ambrosius et al. for the reasons of record.

Applicant's arguments reveal lack of full understanding of this ground of rejection. When the prior art explicitly discloses the same exact composition, albeit without explicit disclosure of use contemplated by a subsequent applicant, it is proper to reject the claims under the alternative ground of 102 and 103(a). See MPEP 2112-2112.01 – see in particular MPEP 2112.01, paragraph with the heading, “ COMPOSITION CLAIMS - IF THE COMPOSITION IS PHYSICALLY THE SAME, IT MUST HAVE THE SAME PROPERTIES.”

Claims 25-27 and 29 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Duschek et al. for the reasons of record.

See the above response for Ambrosius et al.

Claims 18 and 25 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2,098,247 for the reasons of record.

Again, applicant places improper reliance on the meaning of “interference pigment,” and fails to give the claims the “broadest reasonable interpretation consistent with the specification.” MPEP 2111. In reviewing the specification, in particular the paragraph bridging pages 5 and 6,

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nothing in the specification precludes the interpretation that the claims read on nets with metallized reflective coatings, as disclosed by the cited reference.

For these reasons, claims 18-21 and 24-31 must be refused again. Claims 22-23 are allowed; however, if applicant continues to maintain, incorrectly, that “interference pigment” has a specialized meaning instead of a generalized ordinary meaning of a pigment that provides light interference, the Examiner may rescind this indication of allowability and apply a new matter ground of rejection for use of a term and meaning that were not originally disclosed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

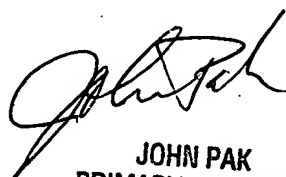
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JOHN PAK
PRIMARY EXAMINER
GROUP 1200